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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,271	02/11/2004	Robert Sconce	Sconce	5436

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Pennington, Hill & Baker, LLP
Attn: Jeffrey N. Collins
Suite 890
777 Taylor Street
Fort Worth, TX 76102

EXAMINER

HAYES, BRET C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,271

Applicant(s)

SCONCE ET AL.

Examiner

Bret C Hayes

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 2,3 and 6-8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to because FIG. 15 appears to have **56a** and **57a** reversed. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. The above requirements will be waived upon showing the examiner's assertion to be incorrect.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed

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150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because Line 2, "Said" should be removed.

Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claims 2, 3 and 6 – 8 are objected to because of the following informalities: claim 2, line 2, replace "a" with --the-- as "a flex plate" has previously been recited in the base claim; claim 3, line 2, replace "a plunger and spring" with --the plunger and a spring-- as "a plunger" has previously been recited in the base claim; claim 7, line 2, "comprising a threaded insert is constructed" should be --...which is constructed--; and claim 8, line 3, replace the 1st recitation of "in" with --is--.

5. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 6 fails to further limit the base claim, claim 1, which requires a threaded insert, while dependent claim 6 attempts to remove that requirement.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 – 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Re – claim 1, at line 3, the recitation “or like strength, rigidity and durability” appears to be unclear, since “polymer” and “plastic” are referenced manufacturing materials. Protein is a polymer of amino acids, but its ability to be machined or formed into a ‘strong, rigid and durable’ sight body is questionable at best. Likewise, polystyrene and polyurethane are plastic having an open cell structure and would hardly be suitable materials for a sight body.

9. Claim 2 recites the limitation "the lower surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 3 recites the limitations "the base" in line 4, and "the vertical height adjustments" in lines 4 and 5. There is insufficient antecedent basis for these limitations in the claim.

11. Claim 4 recites the limitation "the opposite ends" in line 3, and "the vertical height adjustments" in line 4. There is insufficient antecedent basis for these limitations in the claim.

12. Claim 5 recites the limitation "the lower surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

13. Re – claim 6, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Also, see paragraph 8 above regarding polymer and plastic.

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14. Re – claims 7 and 8, see paragraph 8 above regarding a ‘polymer sight body’.

Further, claim 8 recites the limitation "said lower surface" in line 5. There is insufficient antecedent basis for this limitation in the claim. Also, line 5, --or flex washer-- should be inserted after “flex plate” as both are recited previously and considered to be co-limitations.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 1,438,694 to Burton.

17. Burton discloses the claimed invention including: an adjustable sight comprising: a sight body 10 formed of (presumably) metal or any other material of like strength, rigidity and durability; an aperture screw 14; a threaded insert 18; a flex plate 12; and a plunger 25; wherein the body 10 has a cavity 20 which holds the insert 18 which interfaces with the screw 14.

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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19. Claims 2 – 5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton.

20. Re – claim 2, Burton discloses the invention substantially as claimed including the threaded insert functioning in the same manner as a flange, as claimed, except for the threaded insert including a flange. Since Burton discloses the threaded insert acting in the same functional capacity as the claimed flange, the two are art recognized equivalents. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the threaded insert include a flange, since the equivalence of the shoulder disclosed by Burton and a flange for their use in the securing art and the selection of any known equivalents to the shoulder would be within the level of ordinary skill in the art.

21. Re – claim 3, Burton discloses the invention substantially as claimed including a plunger 25 and spring 22 the plunger 25 being biased upwards against the aperture screw 14, via insert 18, and the spring 22 interfacing with a notch 26 in the insert 18. However, Burton does not disclose the plunger 25 being interfacing with a notch in the screw 14. It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the threaded insert and aperture screw, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

22. Re – claim 4, Burton discloses the claimed invention, as applied to claim 3 above, except for the sight body 10 having a spring clip recess. It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the spring clip 22 as disclosed by Burton, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

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23. Re – claim 5, see claim 3 above, and further, Burton discloses a spring, or spring clip 22, as claimed except for a plurality of flex washers (spring 22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a plurality of springs 22, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

24. Concerning method claims 7 and 8 in view of the structure disclosed by Burton, as applied to claims 1 – 5 above, the method of operating the device would have been inherent, since it is the normal and logical manner in which the device could be used.

Conclusion

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (703) 305 – 7421. The fax number is (703) 872 – 9306.

bh

10/29/04



TERI P. LUU
SUPERVISORY PRIMARY EXAMINER